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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/779,588

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Richard Levy

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 12/18/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,588

Applicant(s)

LEVY, RICHARD

Examiner

Margaret B. Medley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 57-80 is/are pending in the application.
- 4a) Of the above claim(s) 69-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Newly submitted claims 69-80 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly added claim 69 (and dependent claims 70-80) are directed to "a substantially anhydrous coating on at least one surface of two surfaces that frictionally engage one another, said coating comprising a superabsorbent polymer further comprising a lubricant wherein said lubricant is a solid inorganic compound ... wherein said lubricant optionally contains a lubricant additive.

The claims of the originally presented invention is directed to claim 57 (and dependent claims 58-68) for " a coating formed on the surface of a substrate, said coating comprising a superabsorbent polymer further comprising a lubricant. The same claims were amended in Paper No. 12 dated August 23, 2002 now define the lubricant of amended claim 57 as wherein said lubricant is a solid organic lubricant ... said lubricants optionally containing a lubricant additive.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 69-80 are withdrawn from consideration as being directed to a non-elected invention by constructed election by original prosecution. See 37 CFR 1.142 (b) and MPEP section 821.03.

Claims 61-62 (and their dependent claims) remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims remain rejected for reasons made of record in Paper No. 7 dated October 23, 2001 and further detailed in Paper No. 10 dated March 28, 2002.

Claims 58, 67 and 68 (and their dependent claims) remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are rejected for reasons made of record in Paper No. 10 dated March 28, 2002.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Germen et al (Germen) WO/93/18233 that has matured into its US counterpart 5,534,304 combined with the Admitted Prior in view of Hopkins, Jr. et al (Hopkins) 5,362,766 and Sayad et al et al (Sayad) 3,336,225

Germen teaches and discloses a method for coating a substrate e.g. fiber or a fibrous product, page 5, lines 19-20, which includes substrates to be treated selected from the group of polyester, aliphatic polyamide, cellulose, polyolefin, polyacrylonitrile, carbon, glass and metal, claim 6, with a layer of a water-in-oil emulsion which contains

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a superabsorbent material (SAP) in its aqueous phase, page 5, lines 21-24. Patentees further teaches that the (SAP) includes water-soluble or water-insoluble material having hydrophilic properties which is capable of absorbing and holding a comparatively large quantity of water, optionally under pressure, page 6, lines 5-32. Germen incorporates the teachings of Arroyo et al (Arroyo) EP 0.351,100 that the SAP includes the ARIDALL polymers that are known to absorb greater than 100 times its weight in water.

Applicants makes admission on record at the paragraph bridging page 21 to pages 22-23 of the instant application that conventional known SAP are known to have the capabilities to absorb greater than 100 times its weight in water. The Admitted Prior Art (SAP) is the same SAP used in the instant application. Applicants further makes admission on record at line 17 of page 24 of the instant application that the ARIDALL (SAP) of the Admitted Prior Art of Arroyo is the same (SAP) used in the instant claims.

The examiner takes the position on record that the lubricant additives of the instant claims are optional components and therefore are not required.

Germen further teaches that commercially available water-in-oil emulsions that contain a (SAP) maybe employed in combination with additives such as lubricants, stabilizers, emulsifiers and/or diluents, Page 8, lines 5-10. Germen teaches ethoxylated oleyl alcohol and ethoxylated oleic acid having use as emulsifiers and as lubricants, page 8, lines 12-14 and that the diluents, include non-aromatic naphthenic and (iso)paraffinic hydrocarbons, page 8, lines 15-18. The stabilizers incorporated into the emulsions of Germen include sorbitan trioleate, mixtures of sorbitan trioleate and

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ethoxylated sorbitan trioleates, sorbitan mono(iso) stearate, and sorbitan mon-oleate, page 8, lines 27-29. Germen further teaches at page 9, lines 6-8 that if so desired, the water-in-oil emulsions may contain the conventional additives such as bactericides and antioxidants. Also Germen teaches that the water-in-oil emulsion maybe applied using methods known in the art, page9, lines 11-13, leaving a homogenous layer of (SAP) on the substrate, page 9, lines 23-26 and Example I, pages 15-18. It is the examiner's position that the instant claims are directed to a coating that has been applied to a substrate by coating a substrate. It is known in the lubricant art that the lubrication composition has to be applied as a coating or to be in contact with a surface in order to exhibit its lubricating properties

Applicant further claims specific lubricants independent claim 57 wherein Germen is silent to said specific teachings.

Applicant makes admission on record at page 19, lines 1-4 that ""For the purpose of the present invention, all of the foregoing lubricant compounds or compositions will be referred to as materials for decreasing friction between moving surfaces or lubricants". The foregoing lubricant compounds or compositions are admitted by applicant at pages 6-19 as conventionally used as lubricant compositions to reduce frictions and are well-known lubricants that includes all of the lubricants and additives of instant claim 57 (and all of its dependent claims). It is the examiner's position that the lubricants are functional equivalents for the intended purposes of lubricating. The picking and choosing of a particular lubricant would be obvious. By applicant own

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admission any lubricant for lubricating purpose will work and are functional equivalent for the intended purpose of lubricating.

Hopkins teaches a process for preparing a composition comprising a matrix of cellulose acetate, glycerin and a superabsorbent polymer, (SAP), e.g. SANWET that is a starched grafted polyacrylate sodium salt that has the capacity to absorb as much as 800 times its own weight in liquid, note Example 1, claims 1-3, abstract, and column 1, line 29 to column 2, lines 1-33.

Sayad teaches a method for reducing friction on substrates that frictional engage one another with a composition comprising a cationic acrylamide polymer, antifoaming agent, soap, water, fatty acid, and corrosion inhibitor, Example III, claims 1-5, column 1, lines 9-17 and column 2, lines 43-47.

It would be obvious to the artisan in the art to select the lubricants and additives and (SAP) of the Admitted Prior Art and the secondary references as the lubricants and additives and (SAP) of the primary because the Admitted Prior clearly teaches that the instant claimed lubricants and additives are functional equivalents for the intended purpose to form a coating on a substrate to for lubricating purpose to reduce friction between moving surfaces. It further would be obvious to the artisan in the art to substitute the (SAP) of the secondary references for the primary references (SAP) because the primary references and the secondary references (SAP) all have the capabilities of absorbing greater than 100 times its weight in water. Thus the instant claims are rendered prima facie obvious.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29-43 of co-pending Application No. 09/357,957. Although the conflicting claims are not identical, they are not patentably distinct from each other because for the reasons made of record in Paper No. 10 dated March 28, 2002.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 57-63 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 57-71 of co-pending Application No. 09/359809. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because for reasons made of record in Paper No. 10 dated March 28, 2002.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 57-68, drawn to a coating formed on the surfaces of a substrate, said coating comprising (SAP), a lubricant and optionally a lubricant additive, classified in class 508, subclass 100+.
- II. Claims 69-80, drawn to A substantially coating on at least one surface of two surfaces that frictionally engage one another said coating comprising a (SAP) and a lubricant and optionally a lubricant additive, classified in class 508, subclass 100+

The inventions are distinct, each from the other because:

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I has separate utility such as used to coat a substrate wherein the coating does not required the coating to be substantially anhydrous. Invention II has a separate utility such as to coat one surface of two surfaces that frictionally engage one another and require the coating to be substantially anhydrous. Thus the two claimed inventions are distinct and independent. See MPEP § 806.05(d).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper..

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

The previous 102 (b) rejections made of record are withdrawn in view of claims amendments to the instant claims of record

Applicant's arguments filed Aug 23, 2002 have been fully considered but they are not persuasive.

Applicants continue to repeat the same arguments presented of record. Therefore, the examiner maintains the arguments previously made of record.

Applicants has presented arguments on record on Paper No 12 dated August 23, 2002 that the pages 17, 8, 12 and 16 of the instant application supports the basis for the cable and wire of claims 61 and 62. The following portions of the instant that applicant has relied is reproduced as follows:

Page 12, lines 1-5 Dispersing the inorganic compounds in various liquids such as lower molecular weight alcohols, glycols, petroleum oils, synthetic oils and water, provides compositions **used in** airframes lubrication, fasteners, such as nuts and bolts or screws, gears, wire drawings, and lubricating fittings.

Page 12, lines 17-24 Polyisobutylenes **find application in** high temperature apparatus such as conveyors, ovens, dryers, and furnaces since they decompose and

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oxidize substantially to entirely volatile by-products leaving no carbon residue contrary to petroleum based lubricants. They **find use in** electrical transformers, cables, and refrigerator compressors with the higher viscosity grades employed as viscosity-index additives in petroleum lubricants.

Page 16, lines 15-20 The emulsions, as that term is used herein, are either water in oil or oil in water emulsions, or oil in oil emulsions where the solution is either the continuous or discontinuous phase. Water dispersions **are used for** lubricating dies, tools, metal-working molds, oxygen equipment and in wire drawing.

The three above passages use the followings "**used in**", "**find application in**", "**find use in**" and "**are used for**". The examiner' maintains the position of record that the said three passage does not provide support for the wire and cable of instant claims 61 and 62.

Page 47, lines 7-11. A formulation of 25 g (25 % w/w) of MARVEL Mystery Oil or ROCYCO 481 Oil is added to 100 g of acetone in **a stainless steel bowl and blended with a KITCHENAID KSM 90 mixer (wire whip attachment; #2 speed)** for ca. minutes in a room maintained at ca. 83% RH and 25 degree Centigrade.

It is the examiner's position that the wire whip attachment of the KITCHENAID mixer that is used to prepare the coating lubricant composition does not provide support for the wire and cable of instant claims 61 and 62.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. B. Medley/mn
November 25, 2002

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER